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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/723,324 | 11/26/2003 | Lingan Satkunanathan | MS302986.01 | 9466 |
| 27195 | 7590 | 08/23/2007 | | |
| AMIN. TUROCY & CALVIN, LLP 24TH FLOOR, NATIONAL CITY CENTER 1900 EAST NINTH STREET CLEVELAND, OH 44114 | | | | EXAMINER |
| | | | | AUGUSTIN, EVENS J |
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| | | | 3621 | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|----------------------------|----------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/723,324 | SATKUNANATHAN ET AL. | |
| | Examiner Evens Augustin | Art Unit 3621 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 07/17/2007.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-4, 6-18, 20-33 and 35-43 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-4, 6-18, 20-33, 35-43 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>5/04/06 & 10/17/06</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The USPTO acknowledged applicant's Request for Continued Examination (RCE) under 37 CFR 1.114, filed on 17 July 2007. Claims 1-4, 6-18, 20-33 and 35-43 are pending in the letter.

Claim Interpretation

2. In determining patentability of an invention over the prior art, the USPTO has considered all claimed limitations, and interpreted as broadly as their terms reasonably allow. Additionally, all words in the claims have been considered in judging the patentability of the claims against the prior art.
3. It should also be noted that, in the office action that:
 - A. Passages in prior art references may be mere rephrasing/rewording of claimed limitations, but the implicit/explicit meaning of the references vis-à-vis the claimed limitation remains intact.
 - B. Functional recitation(s) using the word "for" or other functional terms (e.g. "comprising a license store for storing licenses and data associated therewith" as recited in claim 18) have been considered but given less patentable weight¹ because they fail to add any steps and are thereby regarded as intended use language. To be especially clear, the Examiner has considered all claim limitations. However the A recitation of the intended use of the claimed invention must result in additional steps.

¹ See e.g. *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight).

See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.).

- C. Word(s) that are separated by “/” are being examined as being synonymous or equivalent.
- D. The USPTO interprets claim limitations that contain statement(s) such as “*if, may, might, can, could, when, potentially, possibly*”, as optional language (this list of examples is not intended to be exhaustive). As matter of linguistic precision, optional claim elements do not narrow claim limitations, since they can always be omitted (*In re Johnston*, 77 USPQ2d 1788 (Fed. Circ. 2006)). They will be given less patentable weight, because language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.
- E. Independent claims are examined together, since they are not patentable distinct. If applicant expressly states on the record that two or more independent and distinct inventions are claimed in a single application, the Examiner may require the applicant to elect an invention to which the claims will be restricted.
- F. Any official notices taken by the USPTO that are not adequately traversed by applicant will be taken to be admitted prior art.
- G. The USPTO interprets common computer related words that are not lexicographically defined the word in accordance to Computer Dictionary, 3rd Edition, Microsoft Press,

Redmond, WA, 1997². The USPTO also uses published patent applications and issued patents as well, for meanings of common computer related words that are not lexicographically defined.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claim 1-4, 6-18, 20-33 and 35-43 are rejected under 35 U.S.C. 102(e) as being unpatentable over Christiano (U.S 5,671,412), in view of Rivera et al.(US 6056786).
6. As per claims 1-4, 6-18, 20-33 and 35-43, Christiano discloses a license management system comprising of:
 - A. Determining/monitoring the number of licenses currently in use (column 7, lines 1-45) – *Claims 1, 29,*

² Based upon Applicants' disclosure, the art of record, and the knowledge of one of ordinary skill in this art as determined by the factors discussed in MPEP §2141.03 (where practical), the Examiner finds that the *Microsoft Press Computer Dictionary* is an appropriate technical dictionary known to be used by one of ordinary skill in this art. See e.g. *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1373, 65 USPQ2d 1865, 1872 (Fed. Cir. 2003) where the Federal Circuit used the *Microsoft Press Computer Dictionary* (3d ed.) as “a technical dictionary” to define the term “flag.” See also *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971)(noting that its appropriate to use technical dictionaries in order to ascertain the meaning of a term of art) and MPEP §2173.05(a) titled ‘New Terminology.’

- B. Taking/initiating corrective actions if the number of licenses in use exceeds the number of licenses allowed (column 7, lines 47-67) – *Claims 1, 29*
- C. The license server keeps track of how many licenses are currently checked out and thus can quickly determine if the maximum number of licenses for a program are in use (column 7, lines 9-12) and take corrective actions (column 7, lines 47-67) - *Claim 11*
- D. Corrective action includes a warning (column 7, lines 60-61) – *Claims 2, 37*
- E. Correction action also includes quitting and not allowing the program to be activated (column 7, lines 65-66), therefore denying users access to the application – *Claims 3, 38*
- F. License server (license store), and a license database that houses license data (column 3, lines 63-64, column 4, lines 11-13) – *Claim 4*
- G. A diagnostic function that mitigates various license problems (column 3, lines 18-19) – *Claim 8*
- H. Christiano's invention teaches a "fail safe" mechanism that may allow a license not to be denied (bypass) (column 4, lines 24-26) when the license has been tampered with/corrupted (column 19, lines 19- 21, column 20, lines 21-22, column 18, lines 24-35). A "fail safe" (bypass) mechanism may check a range of server IP addresses to find an network address within a specified range, that can deliver another copy of the licensed program to the client (column 26, lines 9-44). It is well known that each network address represents the location of a computer on a network. Therefore, each

server on a particular address range represents a “backup store” for the licensed program/data – *Claims 6-9, 35*

- I. If the fail safe mechanism cannot be implemented and there’s a violation, the system can quit/shutdown the program (column 7, lines 63-67)- *Claims 10-11, 17, 38*
- J. In order for program/license to be “checked out”, certain information such as user name, host name of client computer system is obtained (log in) (column 4, lines 66-67) – *Claims 12 and 13*
- K. A diagnostic function which can run and be initiated anytime the user is operating the client computer (column 21, lines 25-28), and can diagnose any program normally available on the client’s computer (column 25, lines 15-17) – *Claim 14*
- L. Corrective action includes a warning (column 7, lines 60-61) – *Claim 15*
- M. Correction action also includes quitting and not allowing the program to be activated (column 7, lines 65-66) – *Claim 16*
- N. License server (store), and a license database to house license data (column 3, lines 63-64, column 4, lines 11-13) – *Claim 18*
- O. Verifying the validity of license data (column 27, lines 66-67)
- P. License server/store receiving license request (column 4, line 15), keeping track of licenses being used and taking corrective action if licensing agreement is being violated (column 7, lines 47-67) - *Claim 20*
- Q. Information such as “check out” license and activation data can be logged/saved by the system (column 18, lines 57-lines). It is inherent that a software program has to be installed before being used - *Claims 21, 40*

- R. License data includes the number of licenses available for a particular program (column 14, line 65) – *Claim 22*
- S. Christiano teaches a license management system in which license is granted, based on how much time has elapsed since the licensed program has been in operation (column 7, lines 20-30). In order to establish how much time has elapsed, a beginning time (issue date) is necessary – *Claim 23*
- T. Christiano teaches assigning a unique identifier to a hardware (column 1, lines 28-29), and assigning a unique key to each license (column 7, lines 21-22, lines 65-67) – *Claim 24*
- U. The license is denied to the client when the client violates the licensing policy (column 4, lines 20-24). Christiano's invention teaches a "fail safe" mechanism that allows licenses not to be denied (bypass) (column 4, lines 24-26). Therefore, licenses can be "checked out" when there are no licenses available (column 17, lines 17-21) – *Claim 25*
- V. Bypass mechanism checking a range of IP addresses when failures occur to find an IP address within the specified range that can deliver the licensed program to the client (column 26, lines 9-44) – *Claim 26*
- W. Client computer having display interface to output data (column 6, line 17, column 25, line 46) – *Claims 27,28*
- X. Comparing the number of licenses currently in use plus requested against the number of licenses to be used concurrently (column 19, lines 65-67) – *Claims 30, 31, 33*

Y. If the number of licenses currently being used plus requested is greater than the number of licenses available, than there may be a violation (column 20, lines 1-13) –

Claim 32

Z. License data can be encrypted (column 10, lines 48-49) – *Claim 36*

AA. Computer readable medium, carrying instructions for license management system (column 6, lines 19-59) – *Claims 39 and 43*

BB. Transmitting a license request including information such as client computer identifier (column 21, line 42) and identification information for licensed product (column 10, lines 44-45, column 16, line 30) to a license database. A status message to allow for activation is sent from the license server to the client computer (column 21, lines 47-67) – *Claim 41*

CC. License data includes the number of licenses available for a particular program (column 14, line 65) – *Claim 42*

7. Christiano did not explicitly describe a method/system in which licenses compliance is being checked at a regular time interval. However, Rivera et al. describes an invention that relates to a technique for determining whether the number of users or client computers transacting with a server program exceeds the number of licenses issued for the users or client computers. According to Rivera et al., the invention checks for license compliance by performing an audit of the system (col. 3, ll. 53-61). Per Rivera et al., the system not only designates a time period for checking for license conformance (a time period between 9:15

a.m. and 4:30 p.m. on Jun. 25, 1997), it also establishes a specific regular time interval (every fifteen-minute interval) (col. 7, ll. 9-12) in which the license check should take place.

8. Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to construct a system that would employ a method/system in which licenses are being checked at a regular time interval. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement a method/system in which licenses are being checked at a regular time interval because it provide license administrators with greater flexibility in establishing a time period to ensure that customers comply with the terms of product licenses.

Conclusion

9. *Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that if the applicant is preparing to respond, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.*
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evens Augustin whose telephone number is 571-272-6860. The examiner can normally be reached on Monday thru Friday 8 to 5 pm.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

Andrew Fischer can be reached on 571-272-6779.

/Evens J. Augustin/

Evens J. Augustin

August 19, 2007

Art Unit 3621